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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,619	12/16/2003	Kanako Matsunami	2785-42003800	2632
25225 7590 03/24/2011 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
EXAMINER CHIO, TAT CHI				
ART UNIT		PAPER NUMBER		
2481				
NOTIFICATION DATE		DELIVERY MODE		
03/24/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

EOOfficeSD@mofo.com  
PatentDocket@mofo.com  
Drcaldwell@mofo.com

### Office Action Summary

**Application No.**

10/735,619

**Applicant(s)**

MATSUNAMI, KANAKO

**Examiner**

TAT CHIO

**Art Unit**

2481

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/16/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/25/2011 has been entered.

### ***Response to Arguments***

1. Applicant's arguments filed 1/25/2011 have been fully considered but they are not persuasive.
2. Applicant argues that the combination of Yuyama, Takei, and Yoshinobu does not explicitly teach detecting a receiving state of the waves of television broadcast.
3. In response, the examiner respectfully disagrees. Takei teaches the detection circuit judges the proper reception status, based on the signal level of the received carrier, and the control unit controls the recording operation of the recording unit, based on the result of such judgement [0107] and S803 – S814 of Fig. 8.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuyama et al. (5,825,408), Takei (US 2002/0057350 A1) and Yoshinobu et al. (5,761,372).

**Consider claims 1 and 7**, Yuyama teaches a portable telephone with functions of receiving television and recording capable of programmed recording comprising: **a receiver for receiving waves of a television broadcast** (a first operation mode (during power off) in which the receiver is used as an ordinary telephone...a third operation mode (during power on and the television mode selected by the video-mode select switch) in which the receiver is used as a television receiver in col. 16, lines 55-67 and 209 TV Tuner of Fig. 10). However, Yuyama does not explicitly teach receiving state detector for detecting receiving state of the wave of television broadcast, based on a reception level obtained from the waves of television broadcast, before recording; a memory storing programmed recording information; a detector for detecting that it is at a time point preceding a set start time of the programmed recording based on the programmed recording information stored in the memory, and a receiving state detection activator for activating the receiving state detector a predetermined amount of time preceding the set start time of the programmed recording; a judger for judging whether the recording is permitted based on a detected result of the receiving state detector; and a notifier for notifying the user that such a situation that the recording is not permitted occurs when it is judged that the recording is not permitted, wherein the receiving state comprises the reception level of the television broadcast waves, and the

notifier performs notification by showing on a display a message that the recording is not permitted.

Takei teaches **receiving state detector for detecting receiving state of the wave of television broadcast, based on a reception level obtained from the waves of television broadcast, before recording** (the detection circuit judges the proper reception status, based on the signal level of the received carrier, and the control unit controls the recording operation of the recording unit, based on the result of such judgement [0107] and S803 – S814 of Fig. 8); **a judge for judging whether the recording is permitted based on a detected result of the receiving state detector** (the control unit controls the recording operation of the recording unit, based on the result of such judgement [0107]); **the receiving state comprises the reception level of the television broadcast waves** (the detection circuit judges the proper reception status, based on the signal level of the received carrier [0107]), and **a receiving state detection activator for activating the receiving state detector so that the receiving state detector detects the receiving state a predetermined amount of time preceding the set start time of the recording** (There are further provided operation keys for instructing the recording/reproducing operation of the recording unit in [0096]. The user instructs the recording operation by using the operation keys. When the user instructs the recording operation, he/she activates the receiving state detector. Furthermore, the user is able to choose a time to instruct the recording operation such that the time chosen is preceding the set start time of the recording. The detection circuit judges the proper reception status, based on the signal level of the received

carrier, and the control unit controls the recording operation of the recording unit, based on the result of such judgement [0107] and S803 – S814 of Fig. 8. Because the recording operation of the recording unit is controlled based on the result of the judgment, the reception status is judged before the recording operation is performed), **a notifier for notifying the user that such a situation that the recording is not permitted occurs when it is judged that the recording is not permitted** (a warning message is generated by the character generator, but there may also be utilized an acoustic warning [0132] and stop recording to recording medium temporarily and display warning in S1406 of Fig. 14), **and the notifier performs notification by showing on a display a message that the recording is not permitted** (a warning message is generated by the character generator, but there may also be utilized an acoustic warning [0132] and stop recording to recording medium temporarily and display warning in S1406 of Fig. 14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the known technique of detecting reception status based on the signal level to improve the device taught by Yuyama to suppress the wasted use of the recording medium and the wasted electric power consumption ([0017]).

The combination of Yuyama and Takei does not explicitly teach a memory storing programmed recording information, and a detector for detecting that it is at a time point preceding a set start time of the programmed recording based on the programmed recording information stored in the memory.

Yoshinobu teaches **a memory storing programmed recording information** (the registered reservation unit information is stored in the S-RAM through the CPU, col. 5, lines 31-32), and **a detector for detecting that it is at a time point preceding a set start time of the programmed recording based on the programmed recording information stored in the memory** (the CPU registers the reservation unit so that an interrupt signal will be generated at the time, i.e., M seconds before the recording start in the timer. When the interrupt signal is generated from the timer, the CPU reads out the recording task program stored in the program ROM and drives and executes the retrieved recording task in col. 5, lines 47-50 and col. 5, lines 57-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a memory storing programmed recording information into the system taught by Yuyama and Takei because such incorporation would ensure the recording reservation information in case of electric power suspension.

**Consider claims 3 and 8**, Takei teaches a portable telephone, wherein **the receiving state detector repeats the detection operation after being activated by the receiving state detection activator, the judger repeats the judging operation, and the notifier repeats the notifying operation until it is judged that the recording is permitted or until the user cancels the recording** (if the recording request has not been entered into the control unit, the control unit terminates the recording operation of the recording unit [0100]. The examiner considers that "the recording request has not been entered into the control unit" reads on the limitation "the user cancels the recording").

**Consider claims 6 and 9, Takei teaches a portable television receiver wherein the notifier performs notification by the production of sound** (a warning message is generated by the character generator, but there may also be utilized an acoustic warning [0132]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAT CHIO whose telephone number is (571)272-9563. The examiner can normally be reached on Monday - Thursday 9:00 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/T. C. C./  
Examiner, Art Unit 2481

/Peter-Anthony Pappas/  
Supervisory Patent Examiner, Art Unit 2481